

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUILLERMO RODOLFO CHACON

Appeal No. 2002-1429¹
Application No. 08/941,832

ON BRIEF²

Before THOMAS, HAIRSTON, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand this application to the examiner for action in consideration of the issues addressed below.

¹ This appeal is related to Appeal No. 2002-1624, Application No. 08/941,825.

² The oral hearing scheduled for April 10, 2003 was vacated in view of our decision to remand the application.

REASONS FOR REMAND

The Answer states rejections of claims 37-50 under 35 U.S.C. § 102 as being "clearly anticipated" by, in the alternative, any of twenty patents or publications deemed to be prior art.

Manual of Patent Examining Procedure (MPEP) § 706.02 (8th Ed., Rev. 1, Feb. 2003) states in pertinent part:

CHOICE OF PRIOR ART; BEST AVAILABLE

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

(A) the propriety of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of a claim;

(B) a claim is met only in terms by a reference which does not disclose the inventive concept involved; or

(C) the most pertinent reference seems likely to be antedated by a 37 CFR 1.131 affidavit or declaration.

Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

The instant record does not demonstrate any legitimate reason for the examiner to have entered the large number of prior art rejections. We remand this application to the examiner pursuant to the provisions of 37 CFR § 1.196(a) and MPEP § 1211, which indicates in part that in the case of multiple rejections of a cumulative nature, the Board may remand the application for selection of the preferred or best grounds.

Accordingly, the examiner should select preferred or best grounds of rejection over the prior art for consideration on appeal. A reasonable number of back-up art rejections may be asserted if, for example, the propriety of a rejection depends on a particular interpretation of a claim.

We further note that although the Answer refers to the disclosures of the references, none of the disclosures are directly applied to the requirements of the instant claims. The initial burden of presenting a prima facie case of unpatentability is on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "[T]he Board must assure that the requisite findings are made, based on evidence of record." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

MPEP § 1208 sets forth the following pertinent requirements for an Examiner's Answer, under "12.59 Grounds of Rejection":

(iii) For each rejection under 35 U.S.C. 102, the Examiner's Answer or single prior action, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

....

(v) For each rejection under 35 U.S.C. 102 or 103 where there may be questions as to how limitations in the claims correspond to features in the prior art, the examiner, in addition to the requirements of (ii), (iii) and (iv) above, should compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side by side with a reference to the

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specific page, line number, drawing reference number and quotation from the prior art, as appropriate.


If any of the section 102 rejections are to be maintained, an Answer must point out where all the specific limitations recited in the rejected claims are found in the prior art relied upon. For each rejection over the prior art, the examiner should align the language of a representative claim side by side with reference to the specific page, line number, drawing reference number and quotation from the prior art, as appropriate.


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This application, by virtue of its "special" status, requires an immediate action.
See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED


JAMES D. THOMAS
Administrative Patent Judge


KENNETH W. HAIRSTON
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

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